UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROBERT G. GANN

Appeal No. 2006-1378
Application No. 09/845,852

ON BRIEF

Before JERRY SMITH, RUGGIERO, and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3 and 10-12. Pending claims 4, 5, 13 and 14 had been indicated by the examiner to contain allowable subject matter. Pending claims 6-9 and 15-18 have been withdrawn from consideration by the examiner.

The examiner has now indicated that claims 2 and 11-14 are allowed [answer, page 2]. Accordingly, this appeal is now directed to the examiner's rejection of claims 1, 3 and 10.

The disclosed invention pertains to an image scanner and a method for detecting defects in such a scanner.

Representative claim 3 is reproduced as follows:

3. A method for detecting a defect in image data, comprising:

determining that intensity data, from a particular photosensor, in a particular line-array of photosensors, in a photosensor assembly, is less than a predetermined intensity threshold; and

determining that intensity data, for each photosensor, physically corresponding to the particular photosensor, in all line-arrays in the photosensor assembly other than the particular line-array of photosensors, is not less than the predetermined intensity threshold.

The examiner relies on the following reference:

Palcic et al. (Palcic) 6,026,174 Feb. 15, 2000

Claims 1 and 10 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which appellant regards as the

invention. Claim 3 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Palcic.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the prior art rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that claims 1 and 10 comply with the requirements of 35 U.S.C. § 112. We are also of the view that the disclosure of Palcic does not fully meet the invention as set forth in claim 3. Accordingly, we reverse.

We consider first the rejection of claims 1 and 10 under the second paragraph of 35 U.S.C. § 112. With respect to both claims, the examiner finds that the phrase "a calibration gain for a photosensor corresponding to the line is normal" is vague because it is not clear what a normal calibration means [answer, page 4]. Appellant argues that the specification provides an example of normal in that calibration gains which are above a predetermined threshold are considered to be not normal. Appellant argues that the artisan having read this application would understand what is meant by a gain being normal [brief, pages 5-6]. The examiner responds that different people in the art may have differing views as to what is normal [answer, page 5]. Appellant responds that the word "normal" does not require that everyone in the art have the same range of numbers. He notes that those skilled in the art would understand what is claimed when the claims are read in light of the specification [reply brief, pages 1-2].

We will not sustain the examiner's rejection of claims 1 and 10. A claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971); In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). We agree with appellant that what is normal is described in the specification as being values which fall within a predetermined threshold. Although the threshold is not set to any specific value, this is a matter of breadth and not indefiniteness. Therefore, although the claims might be considered broad, they are not indefinite. The breadth of the claims should be addressed by finding prior art which requires the claims to be narrowed.

We now consider the rejection of claim 3 as being anticipated by the disclosure of Palcic. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). The examiner has indicated how the invention of claim 3 is deemed to be fully met by the disclosure of Palcic [answer, page 4].

Appellant argues that Palcic teaches determining that some image data is less than a threshold, but does not teach associating that data with particular photosensors in multiple line arrays. Appellant argues that the portions of Palcic cited by the examiner have nothing to do with the claimed invention [brief, page 3]. The examiner responds that image pixels are

actually photosensors, and that under this interpretation, the identification of all pixels in Palcic meets the claimed invention [answer, pages 5-6]. Appellant responds that the examiner has adopted a definition of "physically corresponding to" that is inconsistent with the common definition of the term and with the specification. Appellant asserts that physical correspondence requires a same physical relationship to the particular photosensor, such as same row, same column, etc. [reply brief, page 2].

We will not sustain the examiner's rejection of claim 3 for the reasons argued by appellant in the briefs. We agree with appellant that the determination of image pixel values for all pixels in an image does not meet the specific recitations of claim 3. We fail to see how the determination of all pixel values in an image meets the recitation that the data for a particular photosensor physically corresponds to that photosensor in all line-arrays in the photosensor assembly other than the particular line-array of photosensors.

In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 3 and 10 is reversed.

REVERSED

JERRY SMITH)
Administrative Patent Judge)
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JOSEPH F. RUGGIERO) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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